



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/823,334

04/12/2004

Katsushi Horihata

P1338US

4521

1218

7590

09/02/2008

CASELLA & HESPOS  
274 MADISON AVENUE  
NEW YORK, NY 10016

EXAMINER

RILEY, MARCUS T

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/823,334	HORIHATA, KATSUSHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	MARCUS T. RILEY	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04/12/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/12/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/12/2004; 04/28/2008</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2625

## **DETAILED ACTION**

### **Response to Amendment**

1. This office action is responsive to applicant's remarks received on April 30, 2008. Claims 1-12 remain pending.

### **Response to Arguments**

2. Applicant's arguments with respect to claims 1-14, filed on April 30, 2008 have been fully considered but they are not persuasive.

### **A: Applicant's Remarks**

#### **REMARKS**

*Reconsideration of this application is respectfully requested.*

*Claims 1-14 remain in the application.*

*Claim 14 was rejected under 35 USC 102(e) as being anticipated by Gacek (US Patent No. 6,795,205 B1) for the reasons set forth on pages 2-5 of the Office Action dated February 21, 2008. Claims 1-5, 8-10 and 12 were rejected under 35 USC 103(a) as being unpatentable over Gacek in combination with Lewis et al. (US Patent 6,233,565 B1) as set forth on pages 5-20 of the Office Action. Claims 6, 11 and 13 were rejected under 35 USC 103(a) as being unpatentable over Gacek with Lewis as applied to claim 1, and further in view of Lewis as set forth on pages 20-22 of the Office Action. Claim 7 was rejected under 35 USC 103(a) as being unpatentable over Gacek and Lewis as applied to claim 1, and further in view of Tezuka et al. (US 6,018,769) as set forth on pages 23-24 of the Office Action.*

*Gacek is directed to a system for authorizing the transmission of print data generated by a third-party application over a network to a home access device for printing on a printer connected to the home access device. Gacek discloses a system and method for allowing a home user to regulate the type and amount of print jobs that are push- printed, i.e., initiated by a third party other than the home user, to the home user from third- party internet applications, such as third-party merchants 102 and 103. The home user of Gacek provides preferences regarding the push-print service by identifying the third parties from which push-print jobs will always be allowed by the home user for printing on a printer of the home user and the home user provides information regarding the types of third parties from which push-print jobs will be allowed upon prior authorization from an intermediary service. The authorization is obtained from the intermediary service for the internet application, e.g., third party merchants, to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment preferably is transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer, thereby offsetting the expenses related to the printer- related consumables expended during the printing.*

*Lewis is directed is a system and method for conducting Internet based financial transactions between a client and a server. A transaction module is included. The client issues a transaction request to the server in response to the client and server being authenticated. The transaction server executes an electronic payment transaction at the server and records the transaction in the transaction database in response to a client transaction request. A server receipt generation module generates a receipt in response to an executed electronic payment and*

Art Unit: 2625

*transmits the receipt to the client. The receipt includes the client digital signature and a data set uniquely identifying the executed transaction and is printable by the client printer. The printed receipt is evidence of payment for the executed transaction.*

*According to the invention of claim 1 of the present application, when a command requesting transmission of print data is sent from the image forming apparatus to the document server, and a print data recipient is a payer, the document server sends print data and accounting data designating the print data recipient as a payer to the image forming apparatus. When it is judged that the print data provider is a payer, the document server sends print data and accounting data designating the print data provider as a payer to the image forming apparatus. The image forming apparatus collects the fee from the print data recipient when the image forming apparatus receives the accounting data designating the print data recipient as a payer from the document server.*

*On the other hand, Gacek merely discloses a system related to a process of performing data transmission to a user who is permitted to receive data, i.e., a user that allows print data initiated by a third party to be pushed to the user. In the system of Gacek, a user receives third party initiated print data as opposed to print data in response to a request from the user. Gacek does not disclose an image forming apparatus including "an accepting unit that accepts input of a document ID" and "a sending unit that sends the document ID inputted into the accepting unit to the document server" and the document server including "a payer judging unit that judges a payer of the fee relating to printout of the print data, based in the document ID". In this manner, the system of amended claim 1 judges which of the print data recipient and the print data*

Art Unit: 2625

*provider is a payer and charges the fee based on the result, i.e., collecting fees at the image forming apparatus if the print data recipient is a payer.*

*Furthermore, Lewis does not cure the deficiencies of Gacek. The Lewis reference merely discloses a technology of a charging processing, and it does not disclose a fee collecting processing performed in accordance with a payer as set forth in claim 1. Lewis discloses a transaction module wherein, in response to the client and server being authenticated, the client issues a transaction request to the server and the transaction server, in response to a client transaction request, executes an electronic payment transaction at the server and records the transaction in the transaction database. The server receipt generation module, in response to an executed electronic payment, then generates a receipt and transmits the receipt to the client. Lewis does not disclose or suggest a document server including "a controlling unit that controls the data sending unit to send, to the receiving unit of the image forming apparatus, the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the receiving unit of the image forming apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer" (emphasis added). Therefore, it is respectfully submitted claim 1 is not rendered obvious by Gacek and Lewis alone or in any combination, and is in condition for allowance. Claims 2-7 all depend, either directly or indirectly, from claim 1 and are patentable for at least the reasons set forth above in regards to claim 1.*

*Similarly, claim 8 is directed to "[a] document server which is so configured as to receive print data from a contents server providing various information including the print data,*

Art Unit: 2625

*and to send the print data to an image forming apparatus which is installed remotely away from the document server but is communicatively connected therewith via the Internet, the document server comprising: a print data storing unit that stores print data sent from the contents server, and a document ID in association with the print data; a print data retrieving unit that retrieves, from the print data storing unit, the print data in association with the document ID sent from the image forming apparatus; a accounting unit that calculates a fee relating to printout of the print data retrieved by the print data retrieving unit, and stores the fee as accounting data; a payer judging unit that judges a payer of the fee relating to printout of the print data, based on the document ID; a data sending unit that sends the print data and the accounting data to the image forming apparatus; and a controlling unit that controls the data sending unit to send, to the image forming apparatus, the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the image forming apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer" (emphasis added). For at least the reasons put forth for claim 1, it is respectfully submitted claim 8 is not rendered obvious by Gacek and Lewis alone or in any combination, and is in condition for allowance. Claims 9-13 all depend, either directly or indirectly, from claim 8 and are patentable for at least the reasons set forth above in regards to claim 8.*

*Claims 3 and 10 recited "wherein at least one of the document server and the contents server further comprises print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data", in contrast, the portion of Gacek*

Art Unit: 2625

*pointed out by the Examiner relates to whether or not the print job is accepted by the home user. The print job of Gacek is accepted based upon preferences of the home user stored in preferences directory 21 or upon direction of the intermediary server. In neither case are the contents of the print data altered based on the client data of each user. Therefore in addition to the reason put forth for independent claims 1 and 8, claims 3 and 10 are not rendered obvious by the combination of Gacek and Lewis.*

*According to the invention of claim 4 and 11, the document server restricts the number of transmissions of the print data identified by the document ID received from the image forming apparatus. In column 4, lines 10-31 of Gacek recited by the Examiner, a method is generally described for the authorized transmission of print data. No where in the cited passage or anywhere else in Gacek is it described that the number of transmissions of print data is restricted, let alone restricted based on the document ID. Therefore, in addition to the reason put forth for independent claims 1 and 8, claims 4 and 11 are not rendered obvious over the combination of Gacek and Lewis.*

*According to the invention of claim 6 and 13, the document ID is erased upon lapse of a predetermined period from the time when the document ID is received from the contents server. On the other hand, the part of the Lewis reference pointed out by the Examiner discloses that an old certificate for authenticity is deleted and replaced with a new certificate. The invention of claims 6 and 13 and the invention of Lewis are only similar in view of deletion of data. However, according to the invention of claim 6, the document ID is erased upon lapse of a predetermined period from the time when the document ID is received from the contents server so that a period for printing out the print data associated with the document ID can be restricted. The document*



Art Unit: 2625

*ID of claims 6 and 13 is related to the print data whereas the certificate of Lewis is used for authenticating a user via the use of public and private keys. Therefore, in addition to the reason put forth for independent claims 1 and 8, claims 6 and 13 are not rendered obvious over the combination of Gacek and Lewis.*

*Claim 14 was rejected under 35 USC 102(e) as being anticipated by Gacek. Claim 14 is directed to an image forming apparatus including, inter alia, "an inputting unit that allows a user to input a document ID used in verifying that receiving of print data is permitted; a sending unit that sends the document ID inputted to the inputting unit to the server; a receiving unit that receives print data identified by the document ID sent from the sending unit, and accounting data including information relating to a payer which is determined based on the document ID; an outputting unit that outputs the print data received by the receiving unit; and a fee collecting unit that collects a certain fee from a print data recipient if the print data recipient is determined as the payer based on the accounting data received by the receiving unit".*

*The invention of claim 14 is directed to an image forming apparatus, according to which the image forming apparatus sends a command of requesting transmission of print data to the document server, and the image forming apparatus collects fees from a print data recipient when the image forming apparatus receives the accounting data designating the print data recipient as a payer. On the other hand, similar to the reason put forth above in relation to claims 1 and 8, the Gacek reference merely discloses a process of sending data to a user having a permission to receive data. Gacek does not perform collection of fees in accordance with whether the print data recipient is a payer, i.e., collection of fees performed when the print data recipient is a payer. Furthermore, the image forming apparatus of claim 14 includes an inputting section that*

Art Unit: 2625

*allows a user to input a document ID which identified the print data requested, i.e., user initiated. The end user in Gacek requests a print job initiated by a third party without a need for an inputting section since the user of Gacek does not enter a document ID nor requesting specific print data. Therefore, it is respectfully submitted claim 14 is patentably distinct over Gacek and is in condition for allowance.*

*In view of the preceding remarks, it is submitted that the claims remaining in the application are directed to patentable subject matter and allowance is solicited. The Examiner is urged to contact applicants' attorney at the number below to expedite the prosecution of this application.*

**A: Examiner's Response**

Claim 14 remains rejected under 35 USC 102(e) as being anticipated by Gacek (US Patent No. 6,795,205 B1). Claims 1-5, 8-10 and 12 remain rejected under 35 USC 103(a) as being unpatentable over Gacek in combination with Lewis et al. (US Patent 6,233,565 B1). Claims 6, 11 and 13 remain rejected under 35 USC 103(a) as being unpatentable over Gacek with Lewis as applied to claim 1, and further in view of Lewis. Claim 7 remains rejected under 35 USC 103(a) as being unpatentable over Gacek and Lewis as applied to claim 1, and further in view of Tezuka et al. (US 6,018,769).

Gacek does disclose an image forming apparatus including:

an accepting unit that accepts input of a document ID (*"If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305*

Art Unit: 2625

*contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320.” column 11, lines 66-67 thru column 12, lines 1-6);*

a sending unit that sends the document ID inputted into the accepting unit to the document server (*“If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320.” column 11, lines 66-67 thru column 12, lines 1-6); and*

the document server including “a payer judging unit that judges a payer of the fee relating to printout of the print data, based in the document ID (*“Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer.” column 4, lines 31-36).*

Lewis does disclose or suggest a document server including:

a controlling unit that controls the data sending unit to send, to the receiving unit of the image forming apparatus, the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the receiving unit of the image forming

Art Unit: 2625

apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing on the printer. Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer. By virtue of this arrangement, a method is provided whereby third-party-initiated print jobs to a specific home user can be blocked unless payment is provided by the initiating third party to compensate the home user for the ink and paper used during printing of the print job. In another embodiment of the invention, a method is provided for authorized transmission of print data from an internet application residing on a first network to a home access device residing on a second network, the home access device having a printer connected thereto, the second network having a print server which interfaces the first network to the second network and which controls data transmission to the home access device. Print data is generated by the internet application and an intermediary service is*

Art Unit: 2625

*contacted to obtain authorization for the internet application to transmit the print data to the home access device via the print server. A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data.” column 3, lines 52-67 thru column 4, lines 1-22).*

Therefore, it is respectfully submitted claim 1 is rendered obvious by Gacek and Lewis alone or in any combination, and is not in condition for allowance. Claims 2-7 all depend, either directly or indirectly, from claim 1 and are not patentable for at least the reasons set forth above in regards to claim 1.

Regarding claim 8; For at least the reasons put forth for claim 1, it is respectfully submitted claim 8 is rendered obvious by Gacek and Lewis alone or in any combination, and is not in condition for allowance.

Claims 9-13 all depend, either directly or indirectly, from claim 8 and are not patentable for at least the reasons set forth above in regards to claim 8.

Regarding claims 3 and 10; Gacek '205 discloses a print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data (*“Preferably, the system permits the user to preview a single envelope or label by pressing a Print Preview button. This will cause the return address, the mailing address, and a bitmap of a sample indicium 74 to be displayed as it would appear printed. Pressing this button will pass control to a standard Print Preview screen. If the user wishes to print the entire list, the Print All button is selected. Pressing Print All causes a connection to be made to the web server 150 and a file of addresses sent. This file is digitally signed by the client Host 10n for the transaction server 180 to verify. On the transaction server 180, the digital signature on the file will be verified by*

Art Unit: 2625

*validation (also called the security) server 315, each address will be extracted individually and the contents of that address, along with additional information, will be used to create both the human- and computer-readable parts of the indicium 74. See indicium generation 43, FIG. 1A. The postage rate table used is checked to see if it is current, and the postage amounts are recalculated if needed. The contents of the indicium are then hashed (MD5) into a message format and the resulting message is digitally signed by transaction server 180 using the well-known DSA. The indicium is then encrypted for the client to decrypt. The indicium is encrypted to prevent unauthorized capture of the indicium. An unencrypted indicium could be captured, printed, and entered into the mail stream prior to it being obtained by the authorized customer.”* column 19, lines 52-67 thru column 20, lines 1-10).

Here, Lewis is teaching that the contents are being hashed, encrypted and decrypted. It is understood that if the contents are being hashed, encrypted and decrypted, they are being altered. Thus, in addition to the reason put forth for independent claims 1 and 8, claims 3 and 10 are rendered obvious by the combination of Gacek and Lewis.

Regarding claims 4 and 11; Lewis ‘565 discloses wherein the document server restricts the number of transmissions of the print data identified by the document ID received from the image forming apparatus (*“The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate.”* column 30, lines 43-50). Here, Lewis ‘565 is teaching that the server is validating a certificate for authenticity and if it is not

Art Unit: 2625

authenticated, it is then restricted by being deleted/erased. Thus, in addition to the reason put forth for independent claims 1 and 8, claims 4 and 11 are rendered obvious over the combination of Gacek and Lewis.

Regarding claims 6 and 13; Lewis '565 discloses wherein the controlling unit erases the document ID upon lapse of a predetermined period from the time when the document server receives the document ID from the contents server (*"The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate."* column 30, lines 43-50). Here, Lewis '565 is teaching that the server is validating a certificate for authenticity and if it is not authenticated, it is then restricted by being deleted/erased. Thus, in addition to the reason put forth for independent claims 1 and 8, claims 6 and 13 are rendered obvious over the combination of Gacek and Lewis.

Claim 14 was rejected under 35 USC 102(e) as being anticipated by Gacek. Gacek discloses an image forming apparatus, according to which the image forming apparatus sends a command of requesting transmission of print data to the document server, and the image forming apparatus collects fees from a print data recipient when the image forming apparatus receives the accounting data designating the print data recipient as a payer. Similar to the reasons above in relation to claims 1 and 8, the Gacek reference discloses the elements of claim 14. Therefore, it is respectfully submitted claim 14 is not patentably distinct over Gacek and is not in condition for allowance.

Art Unit: 2625

In view of the preceding remarks, Examiner submits that the claims remaining in the application are directed to non-patentable subject matter and is not patentable over Gacek and Lewis, taken alone or in combination.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claim 14** is rejected under 35 U.S.C. 102(e) as being anticipated by Gacek (US 6,795,205 B1 hereinafter, Gacek '205).



Art Unit: 2625

**Regarding claim 14;** Gacek '205 discloses an image forming apparatus which is so configured as to receive print data from a server via the Internet for printout of the print data, the apparatus comprising: (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing."* column 3, lines 52-63): an inputting unit that allows a user to input a document ID used in verifying that receiving of print data is permitted (*"If look-up service 304 provides third-party merchant 302 with identification information, such as a URL, regarding intermediary service 305 (step S403), then flow passes to step S404 in which third-party merchant 302 contacts intermediary service 305 by using the URL. Third-party merchant 302 then proceeds to negotiate with intermediary services 305 in order to obtain authorization for pushing the print job to home user 320..."* column 11, lines 50-57). See also (*"If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320."* column 11, lines 66-67 thru column 12, lines 1-6); a sending unit that sends the document ID inputted to the inputting unit to the server (*"If third-*

Art Unit: 2625

*party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320.*" column 11, lines 66-67 thru column 12, lines 1-6); a receiving unit that receives print data identified by the document ID sent from the sending unit (*"As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.*" column 7, lines 47-62); an accounting data including information relating to a payer which is determined based on the document ID (*"Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer.*" column 4, lines 31-36); an

Art Unit: 2625

outputting unit that outputs the print data received by the receiving unit (“...the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing on the printer.” column 3, lines 57-63); and a fee collecting unit that collects a certain fee from a print data recipient if the print data recipient is determined as the payer based on the accounting data received by the receiving unit (“Preferably, intermediary services 305 and 315 utilize secure connections over internet 301 so that negotiations for authorization to push a print job, instructions to allow the print job to reach the home user's printer, and payment collection and transfer to the home user are conducted in a secure manner. Intermediary services 305 and 315 therefore provide each home user with the ability to control which print jobs are allowed to be push -printed to the home user's printer, if any, and the ability to be compensated for those print jobs which the home user allows.” column 10, lines 29-38).

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 2, 5, 8-10 & 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gacek ‘205 in combination with Lewis et al. (US 6,233,565 B1 hereinafter, Lewis ‘565).

Art Unit: 2625

**Regarding claim 1;** Gacek '205 discloses a wide area network printing system which is so configured that, in response to receiving print data from a contents server providing various information including the print data, a document server sends the print data to an image forming apparatus which is installed remotely away from the document server but is communicatively connected therewith via the Internet for printout, wherein: the image forming apparatus comprises: (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing."* column 3, lines 52-63): an accepting unit that accepts input of a document ID used in verifying that receiving of print data is permitted (*"If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320."* column 11, lines 66-67 thru column 12, lines 1-6); a sending unit that sends the document ID inputted into the accepting unit to the document server (*"If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary*

Art Unit: 2625

*service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320.*" column 11, lines 66-67 thru column 12, lines 1-6); a receiving unit that receives print data from the document server (*"The aforementioned token is preferably sent along with the print job by third-party merchant 302 to CPSI server 312, whereupon the token is inspected by CPSI server 312 and, if found to be authentic, is used by CPSI server 312 in conjunction with the previously received instructions to determine whether to accept the print job for home user 320. CHE 311 then processes, spools and de-spools the print job, and sends the print job to STB 322 of home user 320.*" column 12, lines 52-60); See also (*"...the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing on the printer.*" column 3, lines 57-63); an outputting unit that outputs the print data (*"...the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing on the printer.*" column 3, lines 57-63); and the document server comprises: a storing unit that stores the print data sent from the contents server, and the document ID in association with the print data therein (*"Preferably, CPSI server 312 controls access to printers of home users by accepting a print job addressed to a home user only if the*

Art Unit: 2625

*print job is specifically allowed according to the preferences of the home user which are stored in preferences directory 21, or if CPSI server 312 has been instructed by an authenticated intermediary service to accept the print job.” column 12, lines 13-19); a print data retrieving unit that retrieves, from the storing unit, the print data identified by the document ID sent from the sending unit (“As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.” column 7, lines 47-62) an accounting unit that calculates a fee relating to printout of the print data retrieved by the print data retrieving unit (“A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data. Authorization is provided from the intermediary service to the internet application to transmit the print data to the home access device via the print server. A notification is sent from the intermediary service to the print server that the intermediary has authorized the internet application to transmit the print data to the home access device. The print data is then transmitted from the internet application to the home access device via the print server for printing on the printer.” column 4, lines 21-31); a payer judging*

Art Unit: 2625

unit that judges a payer of the fee relating to printout of the print data, based on the document ID (*"Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer."* column 4, lines 31-36); a data sending unit that sends the print data and the accounting data to the receiving unit of the image forming apparatus (*"In particular, third-party merchant 102 sends a print job representing a financial statement via internet 101 and digital cable network 105 to the set-top box of home user 115 for printing on a printer of home user 115. This is referred to as "push - printing"."* column 6, lines 54-59); a controlling unit that controls the data sending unit to send, to the receiving unit of the image forming apparatus, the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the receiving unit of the image forming apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data*

Art Unit: 2625

*from the internet application to the home access device via the remote print server for printing on the printer. Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer. By virtue of this arrangement, a method is provided whereby third-party-initiated print jobs to a specific home user can be blocked unless payment is provided by the initiating third party to compensate the home user for the ink and paper used during printing of the print job. In another embodiment of the invention, a method is provided for authorized transmission of print data from an internet application residing on a first network to a home access device residing on a second network, the home access device having a printer connected thereto, the second network having a print server which interfaces the first network to the second network and which controls data transmission to the home access device. Print data is generated by the internet application and an intermediary service is contacted to obtain authorization for the internet application to transmit the print data to the home access device via the print server. A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data.” column 3, lines 52-67 thru column 4, lines 1-22); where the image forming apparatus further comprising fee collecting unit that collects the fee from the print data recipient in the case where the receiving unit of the image forming apparatus receives, from the data sending unit of the document server, the accounting data indicating that the print data recipient is the payer ( “Preferably, intermediary services 305 and 315 utilize secure connections*



Art Unit: 2625

*over internet 301 so that negotiations for authorization to push a print job, instructions to allow the print job to reach the home user's printer, and payment collection and transfer to the home user are conducted in a secure manner. Intermediary services 305 and 315 therefore provide each home user with the ability to control which print jobs are allowed to be push -printed to the home user's printer, if any, and the ability to be compensated for those print jobs which the home user allows."* column 10, lines 29-38).

Gacek '205 does not expressly disclose storing the fee as accounting data.

Lewis '565 discloses and storing the fee as accounting data (*"Electronic payments are reported to the transaction server 180 which then transmits them to a specified financial institution for deposit. Upon receipt back of an authorization code, transaction server 180 then increments the user's descending register 21 in PSC 20n with the correct amount. The ascending and descending registers of each user 2n are stored on the Master Server 300 at RSP 4. Under current Postal Service guidelines, the total maximum amount permitted in the descending register 21 is \$500.00, but any value could be used, as well as no limit at all."* column 12, lines 21-30).

Gacek '205 and Lewis '565 are combinable because they are from same field of endeavor of network systems (*"The server has a network including a transaction server, a transaction database, a server authentication module, and a receipt generation module. An internet connection is used between the client and the server network."* Lewis '565, See "Abstract").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network system as taught by Gacek '205 by adding a storing the fee as accounting data as taught by Lewis '565.

Art Unit: 2625

The motivation for doing so would have been because it would be advantageous to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (*"It is another object of the invention to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (e.g., increased efficiency in scheduling and delivery of packages and mail in electronic commerce that is secure and traceable)." Lewis '565 at column 2, lines 11-14).*

Therefore, it would have been obvious to combine Gacek '205 with Lewis '565 to obtain the invention as specified in claim 1.

**Regarding claim 2;** Gacek '205 discloses wherein at least one of the document server and the contents server further comprises a client data storing unit that stores data relating to clients therein, and the payer judging unit judges whether charging is necessary based on the client data (*"As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user."* column 7, lines 47-62). See also (*"It can be*

Art Unit: 2625

*appreciated that several different means can be utilized to tender the payment. For instance, third-party merchant may have a pre-existing account with intermediary service 305, whereupon the account is simply debited the amount of the payment. Instead, the payment could be directly billed by intermediary service 305 to third-party merchant 302. In another example, third-party merchant 302 may present credit card information to intermediary service 305 which is then verified and charged according to commonly known internet credit card techniques and services.” column 14, lines 22-32).*

**Regarding claim 5;** Gacek ‘205 discloses wherein the document server further comprises a shop information storing unit that stores information relating to a shop where the image forming apparatus is installed, and the print data altering unit alters the contents of the print data to be sent to the image forming apparatus depending on the shop information (“As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.” column 7, lines 47-62).

**Regarding claim 8;** Gacek '205 discloses a document server which is so configured as to receive print data from a contents server providing various information including the print data, and to send the print data to an image forming apparatus which is installed remotely away from the document server but is communicatively connected therewith via the Internet, the document server comprising: (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing."* column 3, lines 52-63); a print data storing unit that stores print data sent from the contents server, and a document ID in association with the print data (*"Preferably, CPSI server 312 controls access to printers of home users by accepting a print job addressed to a home user only if the print job is specifically allowed according to the preferences of the home user which are stored in preferences directory 21, or if CPSI server 312 has been instructed by an authenticated intermediary service to accept the print job."* column 12, lines 13-19); a print data retrieving unit that retrieves, from the print data storing unit, the print data in association with the document ID sent from the image forming apparatus (*"As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from*

Art Unit: 2625

*internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.” column 7, lines 47-62); an accounting unit that calculates a fee relating to printout of the print data retrieved by the print data retrieving unit (“A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data. Authorization is provided from the intermediary service to the internet application to transmit the print data to the home access device via the print server. A notification is sent from the intermediary service to the print server that the intermediary has authorized the internet application to transmit the print data to the home access device. The print data is then transmitted from the internet application to the home access device via the print server for printing on the printer.” column 4, lines 21-31); a payer judging unit that judges a payer of the fee relating to printout of the print data, based on the document ID (“Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer.” column 4, lines 31-36); a*

Art Unit: 2625

data sending unit that sends the print data and the accounting data to the image forming apparatus (*"In particular, third-party merchant 102 sends a print job representing a financial statement via internet 101 and digital cable network 105 to the set-top box of home user 115 for printing on a printer of home user 115. This is referred to as "push -printing".*" column 6, lines 54-59); and a controlling unit that controls the data sending unit to send, to the image forming apparatus, the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the image forming apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing on the printer. Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer. By virtue of this arrangement, a method is provided whereby third-party-*

Art Unit: 2625

*initiated print jobs to a specific home user can be blocked unless payment is provided by the initiating third party to compensate the home user for the ink and paper used during printing of the print job. In another embodiment of the invention, a method is provided for authorized transmission of print data from an internet application residing on a first network to a home access device residing on a second network, the home access device having a printer connected thereto, the second network having a print server which interfaces the first network to the second network and which controls data transmission to the home access device. Print data is generated by the internet application and an intermediary service is contacted to obtain authorization for the internet application to transmit the print data to the home access device via the print server. A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data.” column 3, lines 52-67 thru column 4, lines 1-22).*

Gacek ‘205 does not expressly disclose storing the fee as accounting data.

Lewis ‘565 discloses and storing the fee as accounting data (“*Electronic payments are reported to the transaction server 180 which then transmits them to a specified financial institution for deposit. Upon receipt back of an authorization code, transaction server 180 then increments the user's descending register 21 in PSC 20n with the correct amount. The ascending and descending registers of each user 2n are stored on the Master Server 300 at RSP 4. Under current Postal Service guidelines, the total maximum amount permitted in the descending register 21 is \$500.00, but any value could be used, as well as no limit at all.*” column 12, lines 21-30).

Art Unit: 2625

Gacek '205 and Lewis '565 are combinable because they are from same field of endeavor of network systems (*"The server has a network including a transaction server, a transaction database, a server authentication module, and a receipt generation module. An internet connection is used between the client and the server network."* Lewis '565, See *"Abstract"*).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network system as taught by Gacek '205 by adding a storing the fee as accounting data as taught by Lewis '565.

The motivation for doing so would have been because it would be advantageous to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (*"It is another object of the invention to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (e.g., increased efficiency in scheduling and delivery of packages and mail in electronic commerce that is secure and traceable)."* Lewis '565 at column 2, lines 11-14).

Therefore, it would have been obvious to combine Gacek '205 with Lewis '565 to obtain the invention as specified in claim 8.

**Regarding claim 9;** Gacek '205 discloses client data storing unit that stores data relating to clients therein, and the payer judging unit judges whether charging is necessary based on the client data (*"It can be appreciated that several different means can be utilized to tender the payment. For instance, third-party merchant may have a pre-existing account with intermediary service 305, whereupon the account is simply debited the amount of the payment. Instead, the payment could be directly billed by intermediary service 305 to third-party merchant 302. In*



Art Unit: 2625

*another example, third-party merchant 302 may present credit card information to intermediary service 305 which is then verified and charged according to commonly known internet credit card techniques and services.” column 14, lines 22-32).*

7. **Claims 3, 4, 6, 10-12 &13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gacek ‘205 with Lewis ‘565 as applied to claim 1 above, and further in view of Lewis ‘565.

**Regarding claim 3;** Gacek ‘205 and Lewis ‘565 as modified does not expressly disclose wherein at least one of the document server and the contents server further comprises print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data.

Lewis ‘565 discloses wherein at least one of the document server and the contents server further comprises print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data (*“Preferably, the system permits the user to preview a single envelope or label by pressing a Print Preview button. This will cause the return address, the mailing address, and a bitmap of a sample indicium 74 to be displayed as it would appear printed. Pressing this button will pass control to a standard Print Preview screen. If the user wishes to print the entire list, the Print All button is selected. Pressing Print All causes a connection to be made to the web server 150 and a file of addresses sent. This file is digitally signed by the client Host 10n for the transaction server 180 to verify. On the transaction server 180, the digital signature on the file will be verified by validation (also called the security) server 315, each address will be extracted individually and the contents of that address, along*

Art Unit: 2625

*with additional information, will be used to create both the human- and computer-readable parts of the indicium 74. See indicium generation 43, FIG. 1A. The postage rate table used is checked to see if it is current, and the postage amounts are recalculated if needed. The contents of the indicium are then hashed (MD5) into a message format and the resulting message is digitally signed by transaction server 180 using the well-known DSA. The indicium is then encrypted for the client to decrypt. The indicium is encrypted to prevent unauthorized capture of the indicium. An unencrypted indicium could be captured, printed, and entered into the mail stream prior to it being obtained by the authorized customer.” column 19, lines 52-67 thru column 20, lines 1-10).*

Gacek ‘205 and Lewis ‘565 are combinable with Lewis ‘565 because they are from same field of endeavor of network systems ( *“The server has a network including a transaction server, a transaction database, a server authentication module, and a receipt generation module. An internet connection is used between the client and the server network.”* Lewis ‘565, See *“Abstract”*).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network system as taught by Gacek ‘205 and Lewis ‘565 by adding wherein wherein at least one of the document server and the contents server further comprises print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data as taught by Lewis ‘565.

The motivation for doing so would have been because it would be advantageous to provide products for using electronic commerce payment technologies as well as new approaches to old challenges ( *“It is another object of the invention to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (e.g., increased*

Art Unit: 2625

*efficiency in scheduling and delivery of packages and mail in electronic commerce that is secure and traceable).*” Lewis ‘565 at column 2, lines 11-14).

Therefore, it would have been obvious to combine Gacek ‘205 and Lewis ‘565 with Lewis ‘565 to obtain the invention as specified in claim 1.

**Regarding claim 4;** Lewis ‘565 discloses wherein the controlling unit of the document server restricts the number of transmissions of the print data identified by the document ID to the image forming apparatus when the document server receives the document ID from the image forming apparatus two or more number of times (*“The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate.”* column 30, lines 43-50).

**Regarding claim 6;** Lewis ‘565 discloses wherein the controlling unit of the document server erases the document ID upon lapse of a predetermined period from the time when the document server receives the document ID from the contents server (*“The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If*

Art Unit: 2625

*both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate.” column 30, lines 43-50).*

**Regarding claim 10;** Lewis ‘565 discloses a print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data (*“Preferably, the system permits the user to preview a single envelope or label by pressing a Print Preview button. This will cause the return address, the mailing address, and a bitmap of a sample indicium 74 to be displayed as it would appear printed. Pressing this button will pass control to a standard Print Preview screen. If the user wishes to print the entire list, the Print All button is selected. Pressing Print All causes a connection to be made to the web server 150 and a file of addresses sent. This file is digitally signed by the client Host 10n for the transaction server 180 to verify. On the transaction server 180, the digital signature on the file will be verified by validation (also called the security) server 315, each address will be extracted individually and the contents of that address, along with additional information, will be used to create both the human- and computer-readable parts of the indicium 74. See indicium generation 43, FIG. 1A. The postage rate table used is checked to see if it is current, and the postage amounts are recalculated if needed. The contents of the indicium are then hashed (MD5) into a message format and the resulting message is digitally signed by transaction server 180 using the well-known DSA. The indicium is then encrypted for the client to decrypt. The indicium is encrypted to prevent unauthorized capture of the indicium. An unencrypted indicium could be captured, printed, and entered into the mail stream prior to it being obtained by the authorized customer.”* column 19, lines 52-67 thru column 20, lines 1-10).

**Regarding claim 11;** Lewis '565 discloses wherein the controlling unit restricts the number of transmissions of the print data identified by the document ID to the image forming apparatus when the document server receives the document ID from the image forming apparatus two or more number of times (*"The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate."* column 30, lines 43-50).

**Regarding claim 12;** Lewis '565 discloses a shop information storing unit that stores information relating to a shop where the image forming apparatus is installed (*"The Log Server 195 stores all data used for reporting, both internally to PSP 4 and to the TPS 6. The Log Server 195 also performs all audit functions. Results of these audits will be made available to TPS 6 and in the case of the postage embodiment, to various USPS agencies, as indicated in FIG. 2 as data management module 42 in PSP 4 and data management module 62 in TPS 6."* column 12, lines 63-67 thru column 13, lines 1-2); wherein the print data altering unit alters the contents of the print data to be sent to the image forming apparatus depending on the shop information (*"Preferably, the system permits the user to preview a single envelope or label by pressing a Print Preview button. This will cause the return address, the mailing address, and a bitmap of a sample indicium 74 to be displayed as it would appear printed. Pressing this button will pass*

Art Unit: 2625

*control to a standard Print Preview screen. If the user wishes to print the entire list, the Print All button is selected. Pressing Print All causes a connection to be made to the web server 150 and a file of addresses sent. This file is digitally signed by the client Host 10n for the transaction server 180 to verify. On the transaction server 180, the digital signature on the file will be verified by validation (also called the security) server 315, each address will be extracted individually and the contents of that address, along with additional information, will be used to create both the human- and computer-readable parts of the indicium 74. See indicium generation 43, FIG. 1A. The postage rate table used is checked to see if it is current, and the postage amounts are recalculated if needed. The contents of the indicium are then hashed (MD5) into a message format and the resulting message is digitally signed by transaction server 180 using the well-known DSA. The indicium is then encrypted for the client to decrypt. The indicium is encrypted to prevent unauthorized capture of the indicium. An unencrypted indicium could be captured, printed, and entered into the mail stream prior to it being obtained by the authorized customer.”*

column 19, lines 52-67 thru column 20, lines 1-10).

**Regarding claim 13;** Lewis ‘565 discloses wherein the controlling unit erases the document ID upon lapse of a predetermined period from the time when the document server receives the document ID from the contents server (*“The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions*

Art Unit: 2625

*validate, the old CA's certificate is deleted and replaced with a new CA certificate.*" column 30, lines 43-50).

8. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gacek '205 and Lewis '565 as applied to claim 1 above, and further in view of Tezuka et al. (US 6,018,769 hereinafter, Tezuka '769).

**Regarding claim 7;** Gacek '205 and Lewis '565 as modified does not expressly disclose wherein the contents server sends, to a communications terminal, a warning message indicating that the document ID will be erased upon lapse of the predetermined period, before the predetermined period lapses.

Tezuka '769 discloses wherein the contents server sends, to a communications terminal, a warning message indicating that the document ID will be erased upon lapse of the predetermined period, before the predetermined period lapses. (*"At step 3625, the module receives a message indicating that Erase (E) is selected from the edit menu of the system."* column 23, lines 10-11). See also Figure 36.

Gacek '205 and Lewis '565 are combinable with Tezuka '769 because they are from same field of endeavor of network systems (*"This invention relates to an integrated network installation system which aids in facilitating integrated installation of a network and more particularly to an integrated network installation system which displays a network block diagram on a display section for enabling the user to set the network configuration visually when installing a network."* Tezuka '769 at column 1, lines 13-18).

Art Unit: 2625

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network system as taught by Gacek '205 and Lewis '565 by adding wherein the contents server sends, to a communications terminal, a warning message indicating that the document ID will be erased upon lapse of the predetermined period, before the predetermined period lapses as taught by Tezuka '769.

The motivation for doing so would have been because it would be advantageous to enable the operator to set network functions of information processors connected to the network as printers, clients, or servers while visually recognizing them (*"It is therefore an object of the invention to provide an integrated network installation system which can set installation parameters while simulating the network to be installed and more particularly to an integrated network installation system which enables the operator to set network functions of information processors connected to the network as printers, clients, or servers while visually recognizing them."* Tezuka '769 at column 2, lines 11-14).

Therefore, it would have been obvious to combine Gacek '205 and Lewis '565 with Tezuka '769 to obtain the invention as specified in claim 1.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



Art Unit: 2625

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus T. Riley  
Assistant Examiner  
Art Unit 2625

/Marcus T Riley/  
Examiner, Art Unit 2625

Application/Control Number: 10/823,334  
Art Unit: 2625

Page 41